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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,273	12/09/2003	Laval Chan Chun Kong	VIRO-6	2533
23599	7590	03/21/2006	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			CHANG, CELIA C	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,273

Applicant(s)

CHAN CHUN KONG ET AL.

Examiner

Celia Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-22 are pending.

2. *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 9, 18 and 1-8, 15 when W is not nucleosides, drawn to thienylpiperidines and compositions, classified in class 546, subclass 212.
- II. Claims 1-8, 15 when W is nucleosides, drawn to nucleosides and compositions thereof, classified in class 536, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species is also required. Further restriction based on the species election is also required.
- III. Claims 10, 13-14, drawn to method of treating Flaviviridae viral infection, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single disclosed species of compound for the treatment of a single infection is also required. Further restriction based on the species election is also required.
- IV. Claims 19-21, drawn to method of inhibiting or reducing the activity of viral polymerase, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single disclosed compound for inhibiting activity of a single disclosed species of viral polymerase is also required. Further restriction based on the species election is also required.
- V. Claims 16-17, 22, drawn to combination composition, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed combination with every elements of the composition identified and named. Further restriction based on the species election is also required.
- VI. Claims 11-12, drawn to method of treating Flaviviridae viral infection using multiple active ingredients, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single disclosed combination use of active ingredients with every element identified and named to

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be used for the treatment of a single infection is also required. Further restriction based on the species election is also required.

The inventions are independent or distinct, each from the other because:

Inventions Groups I- and II compounds are independent and distinct because the compounds differ in elements, bonding arrangement and chemical properties to such an extent that a reference anticipating one group would not render the other group obvious.

Inventions I-II and III-IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the claimed compounds can be used for at least two methods i.e. group III or group IV. In addition, it is evidenced that treatment of viral infection can be achieved by nucleosides such as found in CA 139:365176.

Invention V, combination composition is independent and distinct from single active ingredient composition because activity of a multiple active ingredient composition depend not solely on one component but the combined effect may it be additive, synergistic or antagonistic among the different ingredients. Thus such invention is unrelated to compound per se or single active ingredient composition.

Invention VI, method of treatment using combination of active ingredients is independent and distinct from single active ingredient method because not efficacy of such method depend not solely on one component but the combined effect may it be additive, synergistic or antagonistic among the different ingredients, but also depending upon how such multiple ingredients are being administered i.e. co-administration, sequential administration, multiple site administration etc. Thus such invention is unrelated to compound per se or method of using a single active ingredient for treatment.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a group and also a species of the invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

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The election of an group or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the groups or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

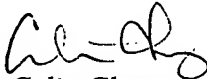
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Mar 16, 2006


Celia Chang
Primary Examiner
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